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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/731,231 12/07/00 GUEGLER

K CL001007

025748
CELERA GENOMICS CORP.

HM22/1022

ATTN: ROBERT A. MILLMAN, PATENT DIRECTOR
45 WEST GUDE DRIVE

C2-4#20
ROCKVILLE MD 20850

EXAMINER

MONSHIPOURI, M

ART UNIT

PAPER NUMBER

1652
DATE MAILED:

10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/731,231

Applicant(s)
Guegler et al.

Examiner
Maryam Monshipouri

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-23 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-2 and 20-21, drawn to isolated peptides encoding human kinases ,
classified in class 435, subclass 194.
- II. Claim 3, and 12-13, drawn to antibodies which specifically bind said peptides a
method of detecting the presence of said peptides in a sample comprising
contacting said sample with a detection agent that specifically allows detection of
said peptides, classified in class 435, subclass 7.1.
- III. Claims 4-6, 8-11 and 22-23, drawn to isolated nucleic acids molecules encoding
said kinases, gene chips and host cells comprising said nucleic acids and methods
of expressing said nucleic acids, classified in class 435, subclass 194.
- IV. Claim 7, drawn to a transgenic non-human animal comprising said nucleic acids,
classified in class 800, subclass 8.
- V. Claims 14-16 and 19, drawn to a method of identifying modulators which bind,
change activity, or change expression of said peptides of said peptides, classified
in class 435, subclass 15.
- VI. Claim 17, drawn to a pharmaceutical composition comprising a modulator of said
peptides, classification unknown. This is because modulators are classified based

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on their chemical structures. Here, applicant did not identify chemical structures of said modulators and thus, classification is not possible.

- VII. Claim 18, drawn to a method of treating a disease or condition mediated by said kinases comprising administering to a patient an effective amount of said modulators, classified in class 514, subclass 789.

The inventions are distinct, each from the other because of the following reasons:

The peptides of Group I, the antibodies of Group II, the DNA of Group III, the transgenic animal of Group IV and the modulators of Group VI are patentably distinct each from the other because each product has unrelated chemical structure and function.

The peptides of Group I, the antibodies of Group II, the DNA of Group III, the transgenic animal of Group IV and the modulators of Group VI are each patentably distinct from any of the methods of Group V and VII because said products are neither made nor used in said methods.

Inventions VI and V or VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the modulators of said kinases may be used for an in vivo method of increasing or decreasing the activity of said kinases, which is an entirely different method than those of Groups V or VII.

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The methods of Group V and VII are patentably distinct because each method has different steps and different end-points.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their separate classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

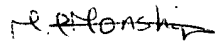
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maryam Monshipouri, Ph.D. whose telephone number is (703) 308-1083.

The Examiner can normally be reached daily from 8:00 A.M. to 5:00 P.M. except for Fridays.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. P. Achutamurthy, can be reached at (703) 308-3804. The OFFICIAL fax number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.



Maryam Monshipouri, Ph.D.

Patent Examiner